

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: TORSTEN WAHLER

Application No. 10/537,905
Technology Center 3600

Mailed: 11 May 2009

Before KRISTA ZELE *Deputy Chief Appeals Administrator.*

ZELE, *Deputy Chief Appeals Administrator.*

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on April 30, 2009 the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

APPEAL BRIEF, CLAIMS APPENDIX

A review of the Appeal Brief filed November 26, 2008 reveals that claim 1 in the Claims appendix of the Appeal Brief is not consistent as amended in the last entered amendment filed on March 4,

2008. The copy of the claims should be in proper format and should not include any markings such as brackets or underlining except for claims in a reissue application in accordance with 37 C.F.R. § 41.37(c)(1)(viii).

Furthermore, the Claims Appendix cannot assume entry of After Final Submissions for which an Advisory Action (or other Office communication) has not advised of entry. *See also Manual of Patent Examining Procedure* (MPEP) § 1205.02 (8th ed. Rev. 6, Sept 2007) for details.

Specifically, claim 1, as provided in the Brief's Claims Appendix, reads:

1. A gearing comprising:

a fixed, internally toothed internal gear;

an annular, flexible toothed band arranged so as to engage with the toothing of the internal gear, the toothed band having fewer teeth than the internal gear;

a rotatable wave generator arranged to transmit a force to the toothed band via a tappet gear such that a relative motion of the toothed band with respect to the internal gear results from a rotation of the wave generator,

a mating gear; and

driving pins shaped on a lateral face of the toothed band and arranged to engage in recesses in the mating gear,

wherein axes of the wave generator and of the mating gear are parallel,

wherein the recesses in the mating gear are radially extending grooves,

wherein a difference between the outer edge and the inner edge on a circular arc does not equal zero, and

wherein the difference is selected so that an outer distance between opposing outer edges of a groove is larger than an inner distance between opposing inner edges of a groove.

However, in the last entered Amendment dated March 4, 2008,

Claim 1, reads:

1. A gearing comprising:

a fixed, internally toothed internal gear;

an annular, flexible toothed band arranged so as to engage with the toothing of the internal gear, the toothed band having fewer teeth than the internal gear;

a rotatable wave generator arranged to transmit a force to the toothed band via a tappet gear such that a relative motion of the toothed band with respect to the internal gear results from a rotation of the wave generator,

a mating gear; and

driving pins shaped on a lateral face of the toothed band and arranged to engage in recesses in the mating gear,

wherein axes of the wave generator and of the mating gear are parallel,

wherein the recesses in the mating gear are radially extending grooves,

wherein each groove has an outer edge and an inner edge,

wherein a difference between the outer edge and the inner edge on a circular arc does not equal zero, and

wherein the difference is selected so that an outer distance between opposing outer edges of a groove is larger than an inner distance between opposing inner edges of a groove.

Appropriate correction of the claim provided in the Claims Appendix in proper format is required.

EXAMINER'S ANSWER, MISSING CERTIFIED TRANSLATION

The Examiner relied on the foreign reference DE 4038555A1 Fischer in rejecting the claims. Full certified English translation of the above noted

foreign reference is not of record in the Image File Wrapper (IFW).

When an Examiner relies on a document “in a language other than English, a translation *must* be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection” (emphasis added). MPEP § 1207.02. Pursuant to a memorandum dated April 29, 2002 by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy:

Effective immediately, no appeal should be forwarded to the Board of Patent Appeals and Interferences for decision where: (1) a rejection is supported in whole or part by an abstract without reference to the underlying document, . . . ; or (2) a rejection is supported in whole or part by a prior art document not in the English language, unless accompanied by a translation of the prior art document into English.

The memorandum also states “[i]f the document is in a language other than English and the examiner seeks to rely on that document, a translation *must* be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection” (emphasis added).

Accordingly, it is **ORDERED** that the application is returned to the Examiner:

- 1) for correction of the Claims Appendix of the Brief filed November 26, 2008;

- 2) to obtain full certified English language translation of the above noted foreign reference;
- 3) to complete the IFW by having the translation obtained scanned into the IFW file;
- 4) to provide copies of the translation obtained to Appellant; and
- 5) for such further action as may be appropriate, consistent with Office policy and practice.

KZ/MV/yr

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